



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/269,037	06/07/1999	JOACHIM WIETZKE	10191/994	9313

26646 7590 09/15/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

MCCHESENEY, ELIZABETH A

ART UNIT	PAPER NUMBER
----------	--------------

2644

DATE MAILED: 09/15/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/269,037

Applicant(s)

WIETZKE ET AL.

Examiner

Elizabeth A McChesney

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

Art Unit: 2644

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. **Claims 11, 13-19, 21, 23-33** are rejected under 35 U.S.C. 102(e) as being anticipated by Eisele et al. (US Patent No. 6,315,207).

Regarding **claim 11**, Eisele et al. (hereinafter, "Eisele") discloses a pocket interface unit (PIU) in conjunction with a smart diskette which includes a chip card 118 (figure 11b), and incorporates electrical contacts and, or a read/write unit (col. 5-lines 57-58). Eisele further discloses the PIU is equipped with a microphone which could be used as a dictation device where spoken work is digitized and stored. The PIU with the smart diskette including chip card could be programmed to respond to simple voice commands as "save" and "run" which reads on outputting the stored message upon request in user-initiated response (col. 13-lines 24-35). The chip card is removable from the read/write unit via the smart diskette and is also removable from the smart diskette as well.

Art Unit: 2644

Regarding **claim 13**, Eisele further discloses outputting spoken text through the loudspeaker (col. 13-lines 42-47).

Regarding **claim 14**, Eisele further discloses a display wherein it inherent to output via the display (col. 13-lines 42-47).

Regarding **claim 15**, Eisele further discloses outputting spoken text through the loudspeaker (col. 13-lines 42-47), which is inherent that the message is being played back via the electrical device.

Regarding **claim 16**, Eisele further discloses the data on the smart diskette can be transferred later to a portable or desk-top PC, which reads on playing back the message via a second device.

Regarding **claim 17**, see Examiner's comments regarding claim 14.

Regarding **claim 18**, see Examiner's comments regarding claim 13.

Regarding **claim 19**, it is inherent that the length of the message is dependent on the capacity of the chip card.

Regarding **claim 21**, Eisele discloses a pocket interface unit (PIU) in conjunction with a smart diskette which includes a chip card 118 (figure 11b), and incorporates electrical contacts and, or a read/write unit (col. 5-lines 57-58). Eisele further discloses the PIU is equipped with a microphone (input device) which could be used as a dictation device where spoken work is digitized (which inherently teaches a voice module) and therefore stored. The smart diskette including chip card also includes a microprocessor for performing such tasks as memory (col. 2-lines 1-8). The PIU with the smart diskette including chip card could be programmed to respond to simple voice commands as

Art Unit: 2644

“save” and “run” which reads on outputting the stored message upon request in user-initiated response (col. 13-lines 24-35). The chip card is removable from the read/write unit via the smart diskette and is also removable from the smart diskette as well.

Regarding **claim 23**, Eisele discloses a microphone as an input device (col. 13-lines 24-27).

Regarding **claim 24**, Eisele further discloses outputting spoken text through the loudspeaker (col. 13-lines 42-47) of the PIU which reads on the reads on the record/read unit (col. 5-lines 57-58).

Regarding **claim 25**, Eisele further discloses the PIU is equipped with a display wherein it inherent to output via the display (col. 13-lines 42-47).

Regarding **claim 26**, Eisele further discloses multiple input devices, for example microphone, keyboard, and Braille keyboard (col. 13-lines 24, 42 and 51).

Regarding **claim 27**, see Examiner's comments regarding claim 26.

Regarding **claim 28**, see Examiner's comments regarding claim 21.

Regarding **claim 29**, Eisele further discloses multiple input devices, for example microphone, keyboard, and Braille keyboard (col. 13-lines 24, 42 and 51).

Regarding **claim 30**, see Examiner's comments regarding claim 29.

Regarding **claim 31**, Eisele discloses a pocket interface unit (PIU) in conjunction with a smart diskette which includes a chip card 118 (figure 11b), and incorporates electrical contacts and, or a read/write unit (col. 5-lines 57-58). Eisele further discloses the PIU is equipped with a microphone (which acoustically receives the message) which

Art Unit: 2644

could be used as a dictation device where spoken work is digitized and stored. The PIU with the smart diskette including chip card could be programmed to respond to simple voice commands as "save" and "run" which reads on outputting the stored message upon request in user-initiated response (col. 13-lines 24-35). The chip card is removable from the read/write unit via the smart diskette and is also removable from the smart diskette as well.

Regarding claims **32 and 33**, see Examiner's comments regarding claim 29.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisele et al. (US Patent No. 6,315,207).

Regarding **claim 20**, Eisele further discloses the PIU is equipped with a display wherein it would have been obvious for one of ordinary skill in the art to display the remaining memory space (col. 13-lines 42-47).

5. **Claims 12, 22, and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisele et al. (US Patent No. 6,315,207) in view of Siegle et al. (US Patent No. 5,752,177).

Art Unit: 2644

Regarding **claims 12, 22, and 34**, Eisele discloses everything claimed as applied above. However Eisele fails to specifically point out that the read/record unit is mounted in an automobile. However it is well known in the art at the time of the invention that vehicle radio receivers accepted the insertion of chip cards. Siegle et al. discloses a vehicle radio receiver, which included information on a chip card that can be inserted into the radio receiver. Therefore it would have been obvious for one of ordinary skill in the art to have the read/record unit in a vehicle for the convenience and mobility.

Response to Arguments

6. Applicant's arguments filed 6/9/03 have been fully considered but they are not persuasive.

Eisele only refers to the chip card as a disadvantage in the context of it used alone due to insufficient amount that can be stored. However, this means it can be used especially in cases that small amounts of storage is necessary. However, Eisele teaches using a chip card but with a smart diskette to allow for greater advantages and convenience. Regardless of the merit of the Applicant's argument the reference reads on the claims as written. The chip card is in fact removable from the record/read unit.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2644

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. McChesney whose telephone number is (703) 308-4563. The examiner can normally be reached Monday – Friday, 8:00 am – 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

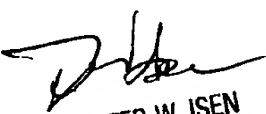
(703) 872-9314 (for Technology Center 2600 only)

Art Unit: 2644

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

EAM *AM*
September 5, 2003


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2650